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09/609,286	06/30/2000	John S. Hendricks	5219.00	2646

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EXAMINER

KE, PENG

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/609,286

Applicant(s)

HENDRICKS ET AL.

Examiner

Peng Ke

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to communications: Amendment, filed on 3/22/04
2. Claims 1-27 are pending in this application. Claims 1, 9, 18, and 22 are independent claims. In the Amendment, filed on 4/30/03, claims 1, 9, 18, and 22 are amended.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lanier et al. (US 5,588,104) in view of Blahu et al. (US 5,446,490).

As per independent claim 22, Lanier et al teaches a method for placing virtual objects into video programs at a viewer's terminal (col 2, lines 36-47), comprising:

receiving one or more virtual objects (col 2, lines 47-63);

receiving a video program including one or more virtual object locations, the video program including virtual object information for placement of virtual objects into the video program (col 2, lines 47-63);

comparing the virtual object information and the received virtual objects to select virtual objects for placement in the virtual object locations (col 3, lines 32- 50); and

inserting the selected virtual objects into the virtual object locations (col 2, lines 47-63).

However, Lanier fails to teach the virtual programs are from a television delivery system.

Blahut et al. teaches broadcasting virtual channels from a television delivery system.

It would have been obvious to an artisan at the time of the invention to include Blahut's teaching with method of Lanier in order to provide user with an interactive television system that is "transparent" to unrestricted channels.

As per claim 25, which is dependent on claim 22, Lanier et al and Blahut teach the method of claim 22, wherein the inserting step occurs during a display of the video program (col 3, lines 32- 50).

Claims 1-6, 8-14, 16-21, 23, 24, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lanier et al. (US 5,588,104) in view of Lanier et al. (5,588,139) further in view of Blahu et al. (US 5,446,490).

As per independent claim 1, Lanier et al. teaches a method for placing virtual objects in virtual object locations in a video program at a viewer's terminal (col 2, lines 36-47), comprising:  
receiving one or more virtual objects for use with one or more of the virtual object locations (col 2, lines 47-63);and

inserting one or more of the received virtual objects into one or more of the virtual object locations during a display or storage of the video program at the viewer's terminal (col 3, lines 32- 50).

However Lanier et al. doesn't teach storing the virtual objects in the viewer's terminals.

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Lanier et al. (5,588,139) teaches storing the virtual objects in the viewer's terminals (paragraph, 30). It would have been obvious to an artisan at the time of the invention to include Lanier et al. (5,588,139)'s teaching with Lanier et al. in order to reduce network traffic.

However, they both fail to teach the virtual programs are from a television delivery system.

Blahut et al. teaches broadcasting virtual channels from a television delivery system.

It would have been obvious to an artisan at the time of the invention to include Blahut's teaching with method of Lanier in order to provide user with an interactive television system that is "transparent" to unrestricted channels.

As per claim 2, which is dependent on claim 1, Lanier et al and Blahut teach the method of claim 1, Lanier ('104) further teaches the method wherein the step of inserting comprises:

selecting a specific virtual object from the one or more virtual objects (col 2, lines 63-67, col 3, lines 1-5).

As per claim 3, which is dependent on claim 1, Lanier et al and Blahut teach the method of claim 2, Lanier ('104) further teaches the method comprising recording virtual objects watched data at the viewer's terminal (col 3, lines 5-20).

As per claim 4, which is dependent on claim 3, Lanier et al and Blahut teach the method of claim 4, Lanier ('104) further comprising adjusting the selecting step based on the recorded virtual objects watched data (col 3, lines 5-20).

As per claim 5, which is dependent on claim 1, Lanier et al and Blahut teach the method of claim 1, Lanier ('104) further teaches method comprising

receiving updated virtual objects at the viewer's terminal (col 3, lines 32- 50); and

Lanier et al. ('139) teaches storing the updated virtual objects in the viewer's terminal (paragraph, 30).

As per claim 6, which is dependent on claim 1, Lanier et al and Blahut teach the method of claim 1, Lanier et al. ('104) further teaches the method wherein at least one virtual object is an interactive virtual object including a link to a location remote from the viewer's terminal, further comprising:

receiving an activation of the interactive virtual object; and

connecting the viewer's terminal to the remote location (col 4, lines 1-14).

As per claim 8, which is dependent on claim 1, Lanier et al and Blahut teach the method of claim 1, Lanier ('104) further teaches the method wherein the viewer's terminal is one of a set top terminal, a television, a personal computer, a satellite television receiver, a wireless telephone, an electronic book reader, and a PDA device (col 2, lines 17-25).

As per independent claim 9, Lanier et al. teaches a terminal that receives virtual objects and video programs having virtual object locations and places the virtual objects into the video programs (col 2, lines 36-47), Lanier ('104) further teaches the method comprising:

a receiver that receives the virtual objects and the video programs (col 2, lines 47-63);

and

a processor that inserts the virtual objects into the virtual object locations during a display of the video programs (col 3, lines 32- 50).

However, Lanier et al doesn't a memory that stores the virtual objects;

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Lanier et al ('139) teaches a memory that stores the virtual object (paragraph, 30). It would have been obvious to an artisan at the time of the invention to include Lanier et al. (5,588,139)'s teaching with Lanier et al. in order to reduce network traffic.

However, they both fail to teach the virtual programs are from a television delivery system.

Blahut et al. teaches broadcasting virtual channels from a television delivery system.

It would have been obvious to an artisan at the time of the invention to include Blahut's teaching with method of Lanier in order to provide user with an interactive television system that is "transparent" to unrestricted channels.

As per claim 10, which is dependent on claim 9, Lanier et al. and Blahut teach the terminal of claim 9, Lanier ('104) further teaches wherein the video programs include a virtual object placement plan, the processor comprising a comparison module that compares the virtual object placement plan and the stored virtual objects to determine a specific virtual object for placement in a specific virtual object location (Lanier et al. col 2, lines 63-67, col 3, lines 1-5, Lanier et al ('139). paragraph 30).

As per claim 11, Lanier et al. ('139) teaches the terminal of claim 10, wherein the virtual object placement plan is stored in the memory (paragraph, 30).

As per claim 12, which is dependent on claim 9, it is of same scope as claim 5. (see rejection above)

As per claim 13, which is dependent on claim 9. Lanier et al. and Blahut teach the terminal of claim 9. However Lanier et al. doesn't teach wherein the processor comprises a virtual objects watched module that determines virtual objects watched at the terminal, the

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virtual objects watched data stored in the memory. Lanier et al. ('139) teaches a terminal wherein the processor comprises a virtual objects watched module that determines virtual object watched at the terminal (paragraph, 17), the virtual objects watched data stored in the memory (paragraph, 30). It would have been obvious to an artisan at the time of the invention to include Lanier et al. (5,588,139)'s teaching with Lanier et al. in order to reduce network traffic.

As per claim 14, which is dependent on claim 13, Lanier et al. teaches the terminal of claim 13, wherein the processor adjusts the virtual object placement plan based on the stored virtual objects viewed data (col 3, lines 32- 50).

As per claim 15, which is dependent on claim 9, it is of the same scope as claim 6. (see rejection above)

As per claim 17, which is dependent on claim 9, it is of the same scope as claim 8. (see rejection above).

As per independent claim 18, Lanier et al. teaches method for placing virtual objects into video programs at a viewer's terminal (col 2, lines 36-47), comprising:

receiving one or more virtual objects (col 2, lines 47-63);

receiving a video program including one or more virtual object locations, the video program including virtual object information for placement of virtual objects into the video program (col 3, lines 32- 50);

comparing the virtual object information and the received virtual objects to select virtual objects for placement in the virtual object locations (col 3, lines 32- 50); and

inserting the selected virtual objects into the virtual object locations (col 2, lines 63-67, col 3, lines 1-5).



However Lanier et al. doesn't teach storing the received virtual objects. Lanier et al. (5,588,139) teaches storing the received virtual objects. It would have been obvious to an artisan at the time of the invention to include Lanier et al. (5,588,139)'s teaching with Lanier et al. in order to reduce network traffic.

However, they both fail to teach the virtual programs are from a television delivery system.

Blahut et al. teaches broadcasting virtual channels from a television delivery system.

It would have been obvious to an artisan at the time of the invention to include Blahut's teaching with method of Lanier in order to provide user with an interactive television system that is "transparent" to unrestricted channels.

As per claim 19, which is dependent on claim 18, Lanier et al and Blahut teach the method of claim 18, Lanier ('104) further teaches the method wherein a viewer receives virtual objects for display based on viewer information including one or more of programs watched data, virtual objects watched data, viewer demographic data, and viewer entered data (col 3, lines 5-20).

As per claim 20, which is dependent on claim 18, it is of the same scope as claim 13. (see rejection above)

As per claim 21, which is dependent on claim 18, Lanier et al and Blahut teach the method of claim 18, Lanier ('104) wherein the video program is stored and the inserting step occurs while the video program is stored (paragraph, 30).

As per claim 23, which is dependent on claim 22, it is of the same scope as claim 1. (see rejection above)

As per claim 24, which is dependent on claim 22, it is of the same scope as claim 21. (see rejection above).

As per claim 26, which is dependent on claim 22, Lanier et al and Blahut teach the method of claim 22. However Lanier et al. ('104) doesn't teach wherein the inserting step occurs during receipt of the video program. Lanier et al. ('139) teaches a method wherein the inserting step occurs during receipt of the video program (paragraph, 30). It would have been obvious to an artisan at the time of the invention to include Lanier et al. ('139)'s teaching with Lanier et al. in order to reduce network traffic.

As per claim 27, which is dependent on claim 22, Lanier et al. and Blahut teach the method of claim 22. However Lanier et al ('104) doesn't teach wherein the video program is displayed multiple times at the viewer's terminal, and wherein virtual objects inserted into the video object locations vary with one or more of the multiple displays of the video program. Lanier et al. ('139) teaches wherein the video program is displayed multiple times at the viewer's terminal, and wherein virtual objects inserted into the video object locations vary with one or more of the multiple displays of the video program (paragraph, 20). It would have been obvious to an artisan at the time of the invention to include Lanier et al. 2's teaching with Lanier et al. in order to create the appearance and reactions of virtual environment and virtual participants are entirely within the control of the user.

Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lanier et al. (US 5,588,104) in view of Lanier et al. (US 5,588,139) further in view of Blahu et al. (US 5,446,490) further in view of de Hond (US 5,737,533).

As per claim 7, which is dependent on claim 6, Lanier et al. and Blahut teach the method of claim 6. However they fail to teach the method wherein the remote location is an Internet web site. De Hond teaches the method wherein the remote location is an Internet web site (col 5, lines 58-60). It would have been obvious to an artisan at the time of the invention to include de Hond's teaching with Lanier et al. and Blahut in order to provide the users with more information regarding the subject.

As per claim 16, which is dependent on claim 15, it is of the same scope as claim 7. (see rejection above)

***Response to Argument***

Applicant's arguments with respect to claims 1-27 have been considered but are deemed to be moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peng Ke whose telephone number is (703) 305-7615. The examiner can normally be reached on M-Th and Alternate Fridays 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L Kincaid can be reached on (703) 308-0640. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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